

REMARKS

Summary of the Office Action

Claims 1-10 stand rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over the Published European Patent Application EP 0 856 972 A2, which was cited in the previous Office Action dated May 17, 2002, in view of *Kinjo et al.* (U.S. Patent No. 6,219,129).

Claims 1-10 stand rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over the Published European Patent Application EP 0 878 956 A1, which was cited in the same previous Office Action, in view of *Kinjo et al.*

Claims 1-10 stand rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over *Ohtsuka* (U.S. Patent No. 6,327,049), which was cited in the previous Office Action dated February 4, 2003, in view of *Kinjo et al.*

Summary of the Response to the Office Action

Applicant respectfully submits that the rejections under 35 U.S.C. §103(a) are improper and therefore should be withdrawn. In addition, Applicant has added new claims 11 and 12 in order to differently describe the invention and provide Applicant with scope to which it is entitled. Accordingly, claims 1-12 are currently pending for further consideration.

All Subject Matter Is Allowable

Claims 1-10 stand rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over the Published European Patent Application EP 0 856 972 A2 in view of *Kinjo et al.* (U.S. Patent No. 6,219,129). Claims 1-10 stand rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over the Published European Patent Application EP 0 878 956 A1 in view of *Kinjo et al.* Claims 1-10 stand rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over *Ohtsuka* (U.S. Patent No. 6,327,049) in view of *Kinjo et al.* Applicant respectfully submits that independent claims 1 and 6 include features not found or taught in cited references EP 0 856 972 A2, EP 0 878 956 A1, *Ohtsuka* and *Kinjo et al.*, whether taken single or combined.

While withdrawing the rejections under 35 U.S.C. §102 in response to the Applicant's Preliminary Amendment with RCE under 37 C.F.R. § 1.114 filed on July 7, 2003, this Office Action cites to *Kinjo et al.* again to reject claims 1-10 under 35 U.S.C. §103(a) as being obvious over the combination of each of EP 0 856 972 A2, EP 0 878 956 A1 and *Ohtsuka* with *Kinjo et al.*

I. Technical Discussion

Applicant respectfully submits that the detailed comments on distinctions between the claimed invention and each of the cited references EP 0 856 972 A2, EP 0 878 956 A1 and *Ohtsuka* have been presented in response to the previous office actions including the Final Office Action dated February 4, 2003. In Preliminary Amendment with RCE filed on July 7, 2003, Applicant respectfully submits that none of the cited references teaches or suggests a remote

photographic processing system where “said photographic printing condition is determined for each original image and set for one original image to achieve coincidence in color or density finishing of photographic prints reproduced from said one original image at the time of said later printing and said previous printing,” as recited by independent claims 1 and 6. Accordingly, Applicant is providing the following comments mainly focusing on the distinctions between *Kinjo et al.* and the claimed invention.

The claimed invention is directed to remote photographic processing system and method with as excellent reproductibility as that in a previous finished print obtained at the time of film processing even when a request for reprinting was made at a different laboratory. To this end, the claimed invention sends photographic printing conditions of each image, which is used when a previous printing (printing with film processing) was performed at each of photographic processing sites, to a center having a database via a communication line from each of the photographic processing sites, and stores the photographic printing conditions in the database.

The photographic printing conditions may be, for example, an exposure condition such as an insertion amount of color filter into an optical path and setting time of a timer in case of an analog photographic processing apparatus, or image processing conditions including LUT that are used for various image processings in case of a digital photographic processing apparatus.

The photographic processing sites access the database at the center to read out the photographic printing conditions of each stored image frame through an ID number of the film later when (re) printing is performed, thereby obtaining photographic prints with similar finishing to that of the previous printing (at the time of film processing).

Unlike the claimed invention, Applicant respectfully submits that *Kinjo et al.* discloses photographic prints with similar finishing to that of the previous printing at the time of processing by a single (same) photographic processing apparatus. Specifically, the photographic processing apparatus stores in the storing means (image recording means) the image processing conditions including LUT used for image processing in the previous printing, when reprinting later, accesses the storing means to read out the image processing conditions of the stored frame through an ID numbers, thereby obtaining photographic prints similar to the previous prints (at the time of film processing).

In other words, *Kinjo et al.* has the storing means within a single photographic processing site to store the image processing conditions equivalent to the photographic printing conditions. Applicant respectfully submits that the claimed invention is distinct from *Kinjo et al.* at least such that the claimed invention has the database to store the photographic printing conditions at the center, which can be accessed from the photographic processing apparatus at any of the photographic processing sites, even though the two inventions are relevant as both having means to store the photographic printing conditions such as image processing conditions and using the photographic printing conditions of the previous printing for reprinting later to achieve coincidence in finishing of both the previous prints and the reprints.

Also, *Kinjo et al.* discloses that a laboratory that receives a request for reprinting may obtain image processing information by accessing a database of another laboratory that has made the previous prints with a personal computer through a computer communication network such as LAN, WAN or the like. Applicant respectfully submits, however, that *Kinjo et al.* neither

teaches nor suggests to store the information in a database at a center to be shared by all of the photographic processing sites and the photographic processing apparatuses.

As pointed out in the Applicant's responses to the previous office actions, Applicant respectfully submits that the Office Action's allegations are incorrect that the previously cited references EP 0 856 972 A2, EP 0 878 956 A1 and *Ohtsuka* disclose the claimed invention, particularly, teach or suggest the photographic print printing conditions of the claimed invention. Therefore, these cited references are distinct from the claimed invention and the allegations are improper.

EP 0 856 972 A2 and *Ohtsuka* both disclose that the photographic processing sites (mini-laboratory 3, laboratory system 2) may exchange any information regarding image generation (instruction information (template information, order file 6 (type of image processing to be performed to the image data)) with the center (service center 2, order receiving center 7) via a communication line such as Internet. Applicant respectfully submits, however, that the information regarding the image generation disclosed in EP 0 856 972 A2 and *Ohtsuka* (template information, order file, etc.) is not equivalent to the photographic printing condition such as the image processing condition disclosed in *Kinjo et al.*

The Office Action appears to construe broadly that the photographic printing conditions may include any kind of condition as long as used for making photographic prints, and goes on to allege that the template information in EP 0 856 972 A2 and the order file 6 in *Ohtsuka* are both photographic printing conditions. Moreover, the Office Action appears to suggest that the image processing condition disclosed in *Kinjo et al.* is to achieve coincidence in the previous

print and the later reprint, and goes to allege that the image processing condition is one of the photographic printing conditions, providing a motivation to combine EP 0 856 972 A2 and *Ohtsuka* with *Kinjo et al.* Applicant respectfully disagrees.

II. Summary

Applicant respectfully submits that EP 0 856 972 A2 and *Ohtsuka* neither teach nor suggest a technical idea to achieve coincidence in finishing (in reproduction of the colors and densities) between the previous prints and the later prints, and *Kinjo et al.* does not teach or suggest a technical idea to store image processing conditions in a database at a center to be shared in order to achieve coincidence in finishing (in reproduction of the colors and densities) between the previous prints and the later prints. Thus, Applicant respectfully submits that there is no motivation to combine EP 0 856 972 A2 and *Ohtsuka* with *Kinjo et al.* at least such that the instruction information including templates and order information of EP 0 856 972 A2 or the order file of *Ohtsuka* (a type of image processing to be written in the order file) can be replaced with the image processing information in order to achieve coincidence in finishing (in reproduction of the colors and densities) between the previous prints and the later prints, after realizing teachings in EP 0 856 972 A2, *Ohtsuka*, and *Kinjo et al.*

Accordingly, at least for these reasons, Applicant respectfully asserts that the rejections of independent claims 1 and 6 under §103(a) should be withdrawn because EP 0 856 972 A2, EP 0 878 956 A1, *Ohtsuka* and *Kinjo et al.*, whether taken singly or combined, do not teach or suggest each and every feature recited by independent claims 1 and 6. As pointed out in MPEP §

2143.03 instructs that "[t]o establish prima facie obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. In re Royka, 409 F.2d 981, 180 USPQ 580 (CCPA 1974)." Furthermore, Applicant respectfully asserts that the rejections of dependent claims 2-5 and 7-10 under §103(a) should also be withdrawn at least because of their dependence upon the respective independent claims 1 and 6 and for the reasons set forth above.

Newly-Added Claims 11 and 12

Claims 11 and 12 have been added in order to differently describe the invention and provide Applicant with scope to which it is entitled.

As discussed above, Applicant respectfully submits that the instruction information including templates and order information of EP 0 856 972 A2, the editorial information of EP 0 878 956 A1, and the order file (a type of image processing to be written in the order file) of *Ohtsuka* are not intended to achieve coincidence in finishing (in reproduction of the colors and densities) between the previous prints and the later prints, and thus are distinct from the photographic printing conditions recited by independent claims 1 and 6 of the claimed invention. In addition, they are not sent from the photographic processing sites to the center.

Applicant respectfully submits that *Kinjo et al.* does not teach or suggest storing the image processing information in order to achieve coincidence in finishing (in reproduction of the colors and densities) between the previous prints and the later prints in a database at a center to be shared.

Further, unlike the claimed invention, Applicant respectfully submits that none of EP 0 856 972 A2, EP 0 878 956 A1 and *Kinjo et al.* discloses sending the photographic printing conditions including the image processing conditions of each original image used for making the photographic prints such as the previous prints, e.g., the prints at the time of film processing at a photographic processing site to the center via a communication line to store in the database, and accessing the database of the center via a communication line from another photographic processing site who received a request for photographic printing of the original image later to obtain the photographic printing conditions of the requested original image from the database.

It is respectfully submitted that the newly-added claims 11 and 12 are in condition for allowance over the art of record for at least the reasons set forth above.

With no other rejection pending, Applicant respectfully asserts that claims 1-12 are in condition for allowance.



Attorney Docket No. 049390-5003
Application No.: 09/558,214
Page 16

CONCLUSION

In view of the foregoing amendments and remarks, Applicant respectfully requests reconsideration and reexamination of this application and the timely allowance of the pending claims. Should the Examiner feel that there are any issues outstanding after consideration of the Response, the Examiner is invited to contact the Applicant's undersigned representative to expedite prosecution.

Applicant respectfully requests an one month extension. Please charge our Deposit Account No. 50-0310 the amount of \$110.00 for one month extension fee.

If there are any other fees due in connection with the filing of this Preliminary Amendment, please charge the fees to our Deposit Account No. 50-0310. If a fee is required for an extension of time under 37 C.F.R. § 1.136 not accounted for above, such an extension is requested and the fee should also be charged to our Deposit Account.

Respectfully submitted,

MORGAN LEWIS & BOCKIUS LLP

By:

Robert J. Goodell
Reg. No. 41,040

Dated: January 5, 2004

Customer No. 009629
MORGAN LEWIS & BOCKIUS LLP
1111 Pennsylvania Avenue, N.W.
Washington, D.C. 20004
202-739-3000 (phone)
202-739-3001 (fax)

RECEIVED
JAN 13 2004
TECHNOLOGY CENTER 2800